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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,909	04/19/2005	Mauro Barbuio	A-9534	3841

7590 08/11/2008  
Hoffman Wasson & Gitler  
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EXAMINER
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MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
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3679

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/531,909	<b>Applicant(s)</b> BARBUIO, MAURO	
	<b>Examiner</b> VICTOR MACARTHUR	<b>Art Unit</b> 3679	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

The amendment filed on 4/21/2008 does not comply with 37 CFR 1.121 (b) (c) (d) and (h). See MPEP 714.02. Specifically, the numbering of claims 10 and 11 has been reversed without showing changes by underlining and strikethrough or double brackets. Note that any future submissions must include the proper claim status identifiers (currently amended) and proper annotation of changes to avoid a holding of non-compliant amendment.

### ***Claim Objections***

All claims are objected to because of the following informalities:

- Claims must be double spaced.
- Each element or step of the claims has not been separated by a line indentation.

See 37 CFR 1.75 and MPEP § 608.01(i)-(p).

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5-7 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Koski (U.S. Patent 5,687,525).

Claim 5. Koski discloses (Figs. 1 and 3-5) an inverted T-beam (75) comprising a central web (central web of 75) having two ends (left and right ends of 75), an appendix (26) extending from one of said ends, said appendix comprising a first portion (remaining portion of 26) and a second portion (41), together forming a V-shape (41 and remaining left portion of 26), a tooth (47) extending from said second portion, said tooth extending away (diagonally as seen in Fig.4) from said first portion. Furthermore:

- In a product claim, the specific method of forming is not germane to the issue of patentability of the device itself. See MPEP § 2113. It is well established by case law that it is the patentability of the product that is to be determined even though such claims are limited and defined by process steps. See *In re Thorpe et al*, 227 USPQ 964 (CAFC 1985). Therefore, the limitation “struck from said second portion” (emphasis added) has been given only limited patentable weight.

Claim 6. Koski discloses s the beam of claim 5, further comprising an aperture (aperture resulting from lancing, col.3, ll.60-61) in the central web having a height corresponding to the height of the second portion.

Claim 7. Koski discloses the beam of claim 5, wherein the first portion has a first section (right section of 26) and a second section (left section of 26), the first section having a greater height than the second section, the first section attached to the central web.

Claim 11. Koski discloses beam of claim 5, wherein the V-shape has the first (41) and second (portion of 26 connected to base of 41) portions joined at a bend (bend at base of 41), the

height (in the direction of the bend) of the first and second portions being equal to one another at the bend.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koski (U.S. Patent 5,687,525).

Claim 4. Koski discloses (Figs. 1 and 3-5) an inverted T-beam (75) comprising: two ends (left and right ends of 75) and a central web (central web of 75); at least one (left end of 75) of said beam's ends having an appendix (26) formed from two portions (left portion of 26, right portion of 26) of a different height, a first inner portion (right portion of 26) extending into a second outer portion (left portion of 26), said outer portion having a lesser height and being a substantial V-shape comprising two parts (41 and remaining left portion of 26) of different length forming two rectilinear legs jointed by a non-rounded portion (where 41 meets 26) of said substantial V-shape, a first part (part of remaining left portion of 26 smaller than 41) of said two parts being coplanar with the first portion and a second part (41) of said two parts having a free end (free end of 41) and comprising a tooth (47) having a free end (free end of 47), the free end of the tooth substantially facing the end of the first portion, the second part having a length

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greater than the fist part, and at least one aperture (18) in the central web having a height substantially corresponding to the height of said outer portion of the appendix. Furthermore:

- The applicant has failed to demonstrate criticality by any showing of unexpected result derived from a rounded shape over a non-rounded shape. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. It has generally been recognized that a change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the prior art non-rounded portion to be shaped as a rounded portion since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).

Claim 10. Koski suggests the beam of claim 4, wherein the legs of the V- shape have the height where the legs are connected.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koski (U.S. Patent 5,687,525) as applied to claims 4-7 and 9-11, above, and further in view of Duffy (U.S. Patent 2,927,384).

Claim 2. Koski suggests (Figs. 2-5) a beam as claimed in claim 4, wherein the appendix is secured to the ends of the beam by cinch-like connection (21 as described in col.3, ll.19-21). Koski does not expressly state what type of cinch-like connection should be used, thus motivating one concerned with constructing the Koski assembly to seek out a specific type of cinch-like connection. Duffy (Fig. 4) teaches that rivets are ideal cinch-like connectors (col.2, ll.39-45). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize a rivet, as taught by Duffy, to construct the Koski assembly since Koski requires the use of such a device and Duffy teaches that rivets are ideal cinch-like connectors.

Claim 8. Koski suggests (Figs. 2-5) a beam as claimed in claim 7, wherein the first section is attached to the central web by cinch-like connection (21 as described in col.3, ll.19-21). Koski does not expressly state what type of cinch-like connection should be used thus motivating one concerned with constructing the Koski assembly to seek out a specific type of cinch-like connection. Duffy (Fig. 4) teaches that rivets are ideal cinch-like connectors (col.2, ll.39-45). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to utilize rivets, as taught by Duffy, to construct the Koski assembly since Koski requires the use of such a device and Duffy teaches that rivets are ideal cinch-like connectors.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koski (U.S. Patent 5,687,525) as applied to claims 4-7 and 9-11, above, and further in view of Brown (U.S. Patent 4,108,563).

Claim 3. Koski suggests a beam as claimed in claim 4, wherein the appendix and beam are of a two piece construction. Brown teaches (col.3, ll.45-50) that one-piece and two-piece constructions are well known to be equivalent alternatives in the art of appendix-beam construction. Therefore, it would have been obvious to one with ordinary skill in the art as a matter of engineering design choice to modify the Koski appendix and beam to be formed in one piece, as taught by Brown, since one-piece and two-piece construction are well known alternatives in the art. Further, the making of what was two pieces into one piece reduces the number of parts.

### ***Response to Arguments***

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

The applicant argues that the newly amended claims overcome the prior art. This is not persuasive. The prior art discloses or suggests all of the applicant's amended claims as detailed above.

All of applicant's claimed limitations are met by the prior art within the broadest reasonable interpretation of the claim language. Subject matter that is not recited in the claims cannot be relied upon to persuasively argue for allowability. Claimed limitations cannot be persuasively argued to have a scope narrower than that, which is reasonably most broad. In a product claim, intended use, labeling and functional language cannot overcome the prior art wherein the prior art discloses structure fully capable of performing such uses and functionality. Capability need not be expressly stated in the prior art wherein it is inherent to the structure.

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Such inherency of functional capability is presumed to be present in the prior art structure until applicant proves otherwise with submission of actual evidence, in accordance with MPEP 2112.01(I). Motivation to combine the references comes from knowledge generally available to one of ordinary skill in the art and the references themselves. Lastly, the Supreme Court has consistently held that where all of the pieces of the invention are known in the prior art it is not patentable to combine known pieces, even to produce beneficial results, unless those results are unexpected and unpredictable. That is to say that if cogent reasoning, based in no part upon hindsight, demonstrates predictability of the new result, a patent will not issue. See In Re Hotchkiss v. Greenwood, 52 U.S. 248, which stated that even beneficial results of being "made firm and strong, and more durable" do not render an invention patentable over the prior art if those results are predictable; see also In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007), which states "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

August 9, 2008

/Victor MacArthur/  
Primary Examiner, Art Unit 3679